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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1964

No. 581

HARRY P. LOCKLIN and ELMER J. BRANT, general partners doing business under the firm name of Radiant Color Company,

Petitioners,

vs.

SWITZER BROTHERS, INC., ROBERT C. SWITZER and JOSEPH L. SWITZER,

Respondents.

PETITION FOR REHEARING

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PETITION FOR REHEARING

Petitioners respectfully pray that this Court rehear and set aside its order denying the writ of certiorari made on January 18, 1965.

1. Petitioners submit that intervening circumstances of substantial and controlling effect should warrant a reconsideration of the denial of the petition. A closely

related issue has come before this Court in another case now pending by the grant of the petition for the writ of certiorari on January 18, 1965 in No. 602 (Walker Process Equipment, Inc. v. Food Machinery and Chemical Corporation).

The first question presented here has within its four corners the first and second questions presented in No. 602. Those matters presented in petitioners' first question here were presented to the Court of Appeals for the Seventh Circuit on propositions of law 1, 2 and 7. These propositions were argued, following a discussion of the fact allegations, on the legal bases set forth at pages 32-34 and 46-47 of Appellants' Opening Brief, included in the record submitted to this Court on the petition. As a convenience, those portions of the brief are reproduced in Appendix A attached hereto.

Proposition 1 so presented to the Court of Appeals, which reads:

> "1. An attempt to monopolize based upon an unwarranted assertion of the patent monopoly is actionable under the antitrust laws, U. S. Code, Title 15, Section 2, where the attempt involves misuse of a lawful patent; or the use of an unlawful patent; or wrongful conduct in the Patent Office to obtain patent; or wrongful conduct in courts to sustain the patent; or a combination of these factors."

relies upon alleged conduct even more revealing of fraud and imposition on the public than the conduct alleged by Walker in questions 1 and 2 of its petition which read:

> "1. Whether it is possible for a person injured in his business by a fraudulently secured patent monopoly on an unpatentable product to have a private

claim for damages, the fraud comprising concealing from the Patent Office, and denying under oath, the facts of the patentee's own invalidating prior sales and use.

"2. Whether a monopoly based on a fraudulently procured patent is exempted and shielded from the clearly expressed prohibitions of Section 2 of the Sherman Act by the mere existence of the patent which is the fraudulent instrument of monopoly."

Both Walker and Radiant presented their claims for relief on the pleadings. In each case, therefore, the District Court did not have the benefit of trial exposure to the proofs which would have established the pleaded misconduct and the Court of Appeals did not have any findings of fact upon which it could factually base either fraud or non-fraud determinations.

The Court of Appeals answered the substantive issue which Walker thus posed in the following key sentence, 335 F. 2d 316, Petition No. 602, Appendix 3a:

"Although patent misuse may be the basis of an independent anti-trust action, *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661 (1944), Walker shows us no case in which the issue of fraud on the Patent Office was used affirmatively in an anti-trust action. . . ."

Circuit Judge Kiley who announced this decision for the Court of Appeals also announced the decision for the Court in the instant case. Thus, when the instant decision came down on July 24, 1964, only nine days after the Walker decision came down on July 15, 1964, the Court did not even discuss propositions of law 1, 2 and 7 pre-

sented by the petitioners in this case. The substantive phases of the petitioners' claims for relief under the antitrust laws silently went down the drain with Walker's claim for relief. With them, silently went petitioners' argument on non-res judicata based on *Mercoid.*

In their respective petitions, Walker and Radiant both urged a conflict between the law applied by the Court of Appeals and the law announced by this Court in parallel cases, to wit *Mercoid Corp. v. Mid-Continent Co.* (1944), 320 U.S. 661; and *Shawkee Mfg. Co. v. Hartford Co.* (1944), 322 U.S. 271. It is manifest that the views of the Court of Appeals as to the scope and meaning of *Mercoid* and *Shawkee* must have influenced its decision in this case as well as in the Walker case.

By the grant of the petition to Walker, it is quite apparent that this Court has tentatively concluded that there is a possibility of error in the views of the Court of Appeals for the Seventh Circuit and that there is a public interest in that issue which is common to the Walker case and the present case. In the present case, Radiant submits that the public interest is at least equal to the public interest shown by Walker and by the Department of Justice as amicus curiae, if not more so.

In Walker, the pleadings allege fraud on the Patent Office alone. The pleadings here not only allege fraud on the Patent Office to obtain a prima facie unwarranted monopoly in the first instance, but they also allege subsequent fraudulent conduct and false representations to the District Court and to the United States Court of Appeals to secure and to retain a favorable adjudication confirming the validity of that monopoly.

In Walker, the patent owner eventually caused a voluntary dismissal of its claim for relief, with prejudice, as the charges of fraudulent conduct began to unfold. In the present case, the patent owner retained its initial victory by successfully opposing a reopening of the case to take evidence and pertinent discovery as the charges of fraudulent conduct began to unfold.

In Walker, the public interest is academic to the extent that the patent there in suit has expired. The present pleadings show that the public interest is real in that the patent involved does not expire until October 18, 1974, more than nine years in the future.

Because of the close parallel of this case with No. 602, petitioners pray that the prior order denying the writ of certiorari be vacated on the authority of Rule 58, section 2; *United States v. Ohio Power Co.* (1957), 353 U.S. 98; *Bradley Mining Co. v. Boice* (1953), 345 U.S. 932; *Skidmore v. Swift & Co.* (1944), 322 U.S. 723; and *Pickett v. Union Terminal Co.* (1941), 314 U.S. 704.

2. Petitioners submit further that there is here a substantial ground available to them although not previously presented. In applying the defense of res judicata to prior motion proceedings brought to open a judgment, the Court of Appeals has decided an important question of federal law which has not been, but should be, settled by this Court.

This Court, in its adoption of Rule 60(b), specifically provided that "This rule does not limit the power of a court (1) to entertain an action to relieve a party from a judgment, order, or proceeding . . ." (308 U.S. 739).

By amendment, this Court subsequently provided that "the procedure for obtaining any relief from a judgment shall be by motion as prescribed in these rules or by an independent action." (329 U.S. 864).

Many authorities are in accord that the procedure which this Court provided in Rule 60(b) is based upon Section 473 of the Code of Civil Procedure of California [Notes of Advisory Committee on Rules; *Fiske v. Buder* (8 Cir. 1942), 125 F. 2d 841; and Moore's Federal Practice, Second Edition, Volume 7, page 10, ¶60.10].

When Rule 60(b) was originally adopted, the California practice under its section 473 had become well settled that res judicata is not applicable to prior unsuccessful motion proceedings brought to reopen the judgment when the res judicata defense was raised in a subsequent independent action. The California practice remains unchanged to date and has demonstrated its worth by history. Landmark cases are *Jeffords v. Young* (1929), 98 Cal. App. 400, at pages 406-407 and *Estudillo v. Security Loan Etc. Co.* (1906), 149 Cal. 556, at page 564. Both cases are referred to in the opinion of the Court of Appeals below and are excerpted in Appendix B attached to this petition.

The Court of Appeals held that "we are compelled by *Heiser v. Woodruff*, 327 U.S. 726 (1945), not to extend the California construction of the rule to the question of whether a ruling on a motion is res judicata of a later independent equitable action." (Petition for Certiorari, App. B, page 9).

Petitioners submit that there is not the slightest word in the entire *Heiser* decision which compelled the Court of Appeals so to disinherit Rule 60(b) by alienating it from its rightful parent. Neither the derivation of Rule 60(b) nor the California practice is even mentioned in the *Heiser* decision. The mere fact that respondents in the *Heiser* case stated the derivation of Rule 60(b) and the California practice at pages 24-25 of their brief filed in the October Term 1945, No. 496 (as respondents in this case pointed out to the Court of Appeals for the Seventh Circuit at page 37 of their brief) does not, petitioners submit, constitute that rejection of the California practice which compelled the Court of Appeals to construe Rule 60(b) without reference to its family tree.

The resolution of this single issue is one peculiarly within an area fully warranting the time and guidance of this Court. This follows not only because Rule 60(b) was promulgated by this Court, but also because the latent recesses of *Heiser* have brought about the present reconstruction of that rule.

Grave injustice has followed the ruling of the Court of Appeals on this critical legal issue. Petitioners here have actually been caught without a remedy for the pleaded fraud for following that well delineated trail which parent authority commends as being "the correct practice" (*Estudillo v. Security Loan Etc. Co.* (1906), 149 Cal. 556, 565, App. B, page ix). Petitioners submit that *Foman v. Davis* (1962), 371 U.S. 178, precludes a summary disposi-

tion of their claims for relief on a technical application of the Rules of Civil Procedure rather than a liberal one.

Petitioners respectfully submit that this case presents a very important problem under the Federal Rules of Civil Procedure as to the applicability of the underlying California law to Rule 60(b) and that the writ should be granted upon the authority of *Hickman v. Taylor* (1947), 329 U.S. 495, 497; and *Schlagenhauf v. Holder* (1964), 379 U.S. 104, 109.

3. Questions arising by virtue of a patentee's alleged fraudulent conduct in the Patent Office and in the courts are of a recurring nature of continuing importance as evidenced by the case study of typical situations collected in Appendix C attached to this petition for rehearing. Paraphrasing the Memorandum of the United States as amicus curiae in No. 602, at page 3, a decision, holding that one who has suffered damages as a result of the suppression of competition under a patent procured by fraud and under an adjudication of validity procured by further fraud may maintain an antitrust action charging illegal monopolization as well as an independent action, would be an important complement to government action, for such a private remedy would bring to light frauds which now pass undiscovered. It would also discourage misrepresentations to the Patent Office and to the courts in infringement suits upon patents thus obtained.

For the foregoing reasons, petitioners respectfully pray that this Court grant this petition for rehearing, vacate the order denying certiorari and grant the petition for the writ of certiorari.

Respectfully submitted,

CARL HOPPE,

Attorney for Petitioners.

WILLIAM J. MARSHALL, JR.,

Of Counsel for Petitioners.

CERTIFICATE OF COUNSEL

Counsel certifies that the foregoing Petition for Rehearing is presented in good faith and not for delay and that the petition is restricted to grounds which are confined to intervening circumstances of substantial or controlling effect and to other substantial grounds available to petitioners although not previously presented.

CARL HOPPE,

Counsel for Petitioners.

(Appendices A, B and C Follow)

Appendix A

EXCERPTS FROM APPELLANTS' OPENING BRIEF, FILED IN THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT IN NOS. 14,383-14384.

PROPOSITIONS OF LAW

1. An attempt to monopolize based upon an unwarranted assertion of the patent monopoly is actionable under the antitrust laws, U. S. Code, Title 15, Section 2, where the attempt involves misuse of a lawful patent; or the use of an unlawful patent; or wrongful conduct in the Patent Office to obtain patent; or wrongful conduct in courts to sustain the patent; or a combination of these factors.

Hartford-Empire Co. v. Glenshaw Glass Co. (W.D. Penn. 1942), 47 F. Supp. 711;

Clinton Engines Corp. v. Briggs & Stratton Corp. (E.D. Mich. S.D. 1959), 175 F. Supp. 390;

United States v. Hartford-Empire Co. (N.D. Ohio W.D. 1942), 46 F. Supp. 541, affirmed and modified in Hartford-Empire Co. v. U. S. (1945), 323 U.S. 386;

Mercoid Corp. v. Mid-Continent Co. (1944), 320 U.S. 661;

United States v. Singer Mfg. Co. (1963), 374 U.S. 174;

Dairy Foods Incorporated v. Dairy Maid Products Coop. (7 Cir. 1961), 297 F. 2d 805; and

Kobe, Inc. v. Dempsey Pump Co. (10 Cir. 1952), 198 F. 2d 416, cert. den. (1953), 344 U.S. 837.

2. The power of the District Court under U. S. Code, Title 15, Section 26, to grant injunctive relief "against threatened loss or damage by a violation of the antitrust

laws . . . when and under the same conditions and principles as injunctive relief against threatened conduct that will cause loss or damage is granted by courts of equity, under the rules governing such proceedings. . . ." extends to prior patent litigation matters.

Hartford-Empire Co. v. U. S. (1945), 323 U.S. 386, 419.

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7. In addition, a claim brought under the antitrust laws is a separate statutory cause of action strictly limiting application of the doctrine of res judicata as it applies to defenses which might have been raised in prior patent litigation.

Mercoid Corp. v. Mid-Continent Co. (1944), 320 U.S. 661, at pages 670-672.

• • • • •

Defendant's conduct violates the antitrust laws.

U.S. Code, Title 15, Section 2 provides:

> "Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor, ..."

The general caveat of *Mercoid Corp. v. Honeywell Co.* (1944), 320 U.S. 680, page 684, is that, "The legality of any attempt to bring unpatented goods within the protection of the patent is measured by the anti-trust laws not by the patent law." This should, we submit, apply with equal force to the legality of any attempt to enforce a patent monopoly which is infested with misrepresentations made both to the Patent Office and to the federal courts.

Many authorities could be collected which illustrate that the antitrust laws are violated whenever one attempts to

establish a monopoly by a misuse of the patent system. Typical examples include the decision by this Court in *Switzer Brothers, Inc. v. Locklin* (7 Cir. 1961), 297 F.2d 39, as well as the decisions in *United States v. Singer Mfg. Co.* (1963), 374 U.S. 174; *Mercoid Corp. v. Mid-Continent Co.* (1944), 320 U.S. 661; *Dairy Foods Incorporated v. Dairy Maid Products Coop.* (7 Cir. 1961), 297 F.2d 805; and *Kobe, Inc. v. Dempsey Pump Co.* (10 Cir. 1952), 198 F.2d 416, cert. den. (1952), 344 U.S. 837.

Moreover, a trend is emerging that any attempt to secure an unwarranted monopoly in any line of commerce through the acquisition of a patent by false representations to the patent office and through the successful prosecution of patent litigation utilizing spurious evidence or other fraud is indeed a violation of the antitrust laws. *Hartford-Empire Co. v. Glenshaw Glass Co.* (W.D. Penn. 1942), 47 F. Supp. 711, 717; *Clinton Engines Corp. v. Briggs & Stratton Corp.* (E.D. Mich. S.D. 1959) 175 F. Supp. 390, 392, 399, 406; *United States v. Hartford-Empire Co.* (N.D. Ohio W.D. 1942) 46 F. Supp. 541, 612; and *Winkler-Koch Engineering Co. v. Universal Oil Prod. Co.* (S.D. N.Y. 1951) 100 F. Supp. 15.

Although none of the cases cited above is based upon precisely the same facts as those in the case at bar, plaintiff submits that by analogy they support the general proposition that any unwarranted attempt to monopolize which is supported by a patent or a judgment of validity and infringement obtained by fraud and misrepresentation is in and of itself a violation of the antitrust laws.

The antitrust laws provide for injunctive relief.

By statute, the victim of an antitrust violation is entitled to injunctive relief "against threatened loss or damage by a violation of the antitrust laws . . . when and under the same conditions and principles as injunctive relief against

threatened conduct that will cause loss or damage is granted by courts of equity, under the rules governing such proceedings, . . .'' [U.S. Code, Title 15, Section 26]. Under case law, the antitrust laws have been invoked to prevent a patentee from enforcing a judgment obtained through the use of spurious evidence in *Hartford-Empire Co. v. U. S.* (1945), 323 U.S. 386 at page 419. The court, at page 392 of its opinion, left "much of the detailed history of the transactions to be gleaned from the opinion below." The opinion below made specific reference to the use of the spurious Clarke article in *United States v. Hartford-Empire Co.* (N.D. Ohio W.D. 1942), 46 F. Supp. 541 at page 612.

* * * * *

The public interest delimits res judicata.

The Court of Appeals for the Ninth Circuit held that the denial of relief in the California proceedings was justified, at least in part, with respect to the showing made with respect to the public welfare (App. 266). In the case at bar, the showing as to public interest has been expanded to include allegations under the antitrust laws showing general public injury (App. 15-16, 45-46).

This question[6] is considered in *Mercoid Corp. v. Mid-Continent Co.* (1944), 320 U.S. 661. In that case it was urged that the issue of patent misuse and violation of the antitrust laws was barred by the doctrine of *res judicata* because the defense could have been raised and decided in earlier proceedings involving the same parties by virtue of the doctrine of privity. In the introductory portion of the opinion of the court, it is pointed out, page 665, "It is the public interest which is dominant in the patent system." Later, the court refused to apply the doctrine of *res judi-*

[6]The Writ of Certiorari was granted "because of the public importance of the questions presented." (320 U.S. 663).

cata because, page 670, "the Court would be placing its imprimatur on a scheme which involves a misuse of the patent privilege and a violation of the anti-trust laws." Finally, at page 671, the court noted that the violation might have been asserted as a defense in the prior suit, but held that this "does not mean that the failure to do so renders the prior judgment *res judicata* as respects it." It was particularly held, page 671, that, "That claim is more than a defense; it is a separate statutory cause of action."

More recently, in *United States v. Singer Mfg. Co.* (1963), 374 U.S. 174, the court considered the filing of patent infringement actions and the settlement of a patent interference conflict, together with other factors, as constituting overt acts in violation of the antitrust laws. The public interest aspect of the patent versus antitrust conflict is brought out in the concurring opinion of Mr. Justice White, 374 U.S. 199, as follows:

> "... There is a public interest here, see *Mercoid Corp. v. Mid-Continent Co.*, 320 U.S. 661, 665; *United States v. Masonite Corp.*, 316 U.S. 265, 278, which the parties have subordinated to their private ends—the public interest in granting patent monopolies only when the progress of the useful arts and of science will be furthered because as the consideration for its grant the public is given a novel and useful invention. U. S. Const., Art. I, § 8; 35 U.S.C. § 101; Statute of Monopolies, 21 Jac. I, c. 3. When there is no novelty and the public parts with the monopoly grant for no return, the public has been imposed upon and the patent clause subverted. *United States v. Bell Telephone Co.*, 128 U.S. 315, 357, 370; see *Katzinger Co. v. Chicago Mfg. Co.*, 329 U.S. 394, 400-401; *Cuno Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 92; *A.&P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 154-155 (concurring opinion). Whatever may be the duty of a single party to draw the prior art to the Office's attention, see 35 U.S.C. § 115; CFR § 1.65(a); *Bell Telephone, supra*, at 356, clearly collusion among applicants to prevent prior art from coming to or being drawn to the Office's

> attention is an inequitable imposition on the Office and on the public. *Precision Instrument Co. v. Automotive Co.*, 324 U.S. 806; see H. R. Rep. No. 1983, 87th Cong., 2d Sess. 1 (Rep. on Pub. L. 87-831). . . ."

The case of *United States v. Bell Telephone Co.* (1888), 128 U.S. 315, to which Mr. Justice White referred, very pointedly states, page 355:

> "It seems to us that if Bell was aware, at the time that he filed his specifications, asserted his claims, and procured his patents, that the same matter had been previously discovered and put into operation by other persons, he was guilty of such a fraud upon the public that the monopoly which these patents grant to him ought to be revoked and annulled. . . ."

At page 357 the court stated further:

> ". . . If such a fraud were practised upon an individual, he would have a remedy in any court having jurisdiction to correct frauds and mistakes and to relieve against accident; . . ."

Similarly, in *Bros Incorporated v. W. E. Grace Manufacturing Company* (5 Cir. 1963), 320 F.2d 594, the court held that prior motions to reopen based upon the filing of false affidavits did not constitute *res judicata*. As to the public interest in analogous proceedings, the court there said, page 609:

> "Another factor, perhaps of even greater importance, is the nature of this litigation. The issue is the validity of a patent. The public interest in a governmentally bestowed monopoly is of transcendent importance. . . ."

Other analogous cases recognizing the public interest in rooting out the misconduct of patentees include *Shawkee Mfg. Co. v. Hartford Co.* (1944), 322 U.S. 271; *Hazel-Atlas Co. v. Hartford Co.* (1944), 322 U.S. 238; and *Precision Co. v. Automotive Co.* (1945), 324 U.S. 806.

Appendix B

EXCERPTS FROM CALIFORNIA CASES ON SECTION 473 OF THE CALIFORNIA CODE OF CIVIL PROCEDURE

Jeffords v. Young (1929), 98 Cal. App. 400, at pages 406-407:

"Finally, it is contended that in an effort to vacate the judgment, having unsuccessfully resorted to the remedy provided by section 473 of the Code of Civil Procedure, the appellants are now barred from applying to equity for the same relief. The remedies for relief from a judgment procured by fraud, mistake or excusable neglect, provided by section 473 of the Code of Civil Procedure, and the ordinary suit in equity are entirely distinct and cumulative. An unsuccessful resort to the first mentioned remedy does not bar an application to equity for relief. (15 Cal. Jur. 27, sec. 127; *Estudillo v. Security L. & T. Co.*, 149 Cal. 556, 561 [87 Pac. 19]; *Bacon v. Bacon*, 150 Cal. 477 [89 Pac. 317]; *Herd v. Tuohy*, 133 Cal. 55, 63 [65 Pac. 139]; 3 Freeman on Judgments, 5th ed., p. 2488, sec. 1198.) In *Bacon v. Bacon, supra*, at page 484, it is said with respect to these different remedies: 'It (sec. 473, Code Civ. Proc.) is a cumulative remedy, and does not displace the remedy in equity. *(Baker v. O'Riordan*, 65 Cal. 368 [4 Pac. 232].) We have recently held not only that it does not displace the equitable remedy, but also that an adverse decision on such a motion does not necessarily bar a subsequent suit to vacate the judgment for the same cause.' To the same effect the author of Freeman on Judgments, *supra*, says: 'The summary disposition of a question upon motion, resulting in a denial of the relief claimed, should not *ipso facto* preclude the party from obtaining the aid of chancery. . . . The denial of a motion to open a judgment should not of necessity preclude a court of equity from subsequently granting the relief denied at law. The decision of such motion is not such a *res adjudicata* as precludes equity from reexamining the question. The opening

of a judgment in a court of law is usually *ex gratia*, while restraining the plaintiff from proceeding on the judgment is, in equity, more nearly a matter of right. The facilities for investigating the issues presented in the motion are usually much better in equity than at law, owing to the more summary character of the motion proceedings.' "

Estudillo v. Security Loan Etc. Co. (1906), 149 Cal. 556, at page 564:

". . . The burden of proof rests upon no one more heavily than upon a plaintiff seeking relief upon the ground of fraud, and he ought not to be unduly hampered as to the means of making proof. In support of a motion he is limited to *ex parte* affidavits of voluntary witnesses unless the court in its discretion permits a wider latitude. In a separate suit he may bring unwilling witnesses into court by subpoena, and he may take their depositions. The remedy is ampler and more efficacious, and the case is one which demands the amplest and most efficacious remedy. My conclusion is that the plaintiffs had the right to maintain this suit, notwithstanding they knew of the frauds alleged in ample time to have moved upon that ground.

"But it is objected, that they did move, and that their right to have the judgment vacated is *res adjudicata*. It does not, however, appear from this complaint that they moved upon the ground of the fraud here alleged, and the report of our decision on the appeal from the order denying the motion shows that it was made upon the ground of want of authority in their attorney to stipulate. The allegations of this complaint do not show that the order denying the motion to vacate is a bar to this action. In Black on Judgments it is said (sec. 321): 'In an action to set aside a judgment on the ground of fraud, neither the judgment thus sought to be vacated, nor an order refusing to set aside a default and permit an answer in that case can be set up as a bar to the action.' From which it would seem to follow that in such a

case as this the correct practice would be to move promptly under section 473 of the Code of Civil Procedure, and if defeated in that proceeding to commence a separate action for relief upon the ground of the plaintiff's fraud—a practice to be commended as convenient and expeditious in case the motion should be granted, and as affording the injured party all the advantage of a regular trial of the issue of fraud if the more summary proceeding proved ineffectual.

"This is the course which plaintiffs have taken, and if the practice is admissible, they cannot be charged with lack of diligence. They moved promptly for relief in the foreclosure suit, and before that motion was finally decided they commenced this action."

Appendix C

STATISTICAL SUMMARY OF CASES MENTIONING ALLEGATIONS OF FRAUD IN CONNECTION WITH THE PROSECUTION OF PATENT APPLICATIONS OR IN CONNECTION WITH THE PROSECUTION OF LITIGATION INVOLVING UNITED STATES LETTERS PATENTS

I. Cases which have reached the Supreme Court

Walker Process Equipment, Inc. v. Food Machinery and Chemical Corporation, October Term, 1964, No. 602.

In this patent infringement case, the alleged infringer filed a counterclaim alleging violation of the antitrust laws by maintaining and enforcing a patent which was obtained through fraud upon the Patent Office. The District Court and the Court of Appeals found that the counterclaim did not state a cause of action. *Food Machinery & Chem. Corp. v. Walker Process Equip., Inc.* (7 Cir. 1964), 335 F. 2d 315. The Supreme Court granted certiorari on January 18, 1965, as No. 602. This case is now pending in the Supreme Court.

Marr v. A. B. Dick Co. (1946), 329 U.S. 680.

The Supreme Court vacated a patent infringement judgment of the Court of Appeals for the Second Circuit and remanded the cause to determine whether the prosecution might not constitute a fraud upon the courts. After remand, the infringer failed to make good his proofs. The underlying infringement action was, however, dismissed and the appeal was dismissed on the ground that the fraud issues had become moot. *A. B. Dick Co. v. Marr* (2 Cir. 1952), 197 F. 2d 498.

Universal Oil Co. v. Root Rfg. Co. (1946), 328 U.S. 575.

The Court considered the role of amici curiae who participated in investigation in which certain patent infringement judgments were vacated because certain testimony pointed to bribery of a judge by a member of the bar to secure a decision favorable to Universal. Subsequently, in *William Whitman Co. v. Universal Oil Products Co.* (D. Dela. 1954), 125 F. Supp. 137, the plaintiff obtained restitution from the patent holder for damages which he sustained by virtue of the judgment entered against him following the favorable decision in the *Root* case and for restitution of monies paid under a license agreement entered into in settlement of the judgment. An antitrust complaint arising out of this case is reported in *Winkler-Koch Engineer. Co. v. Universal Products Co.* (S.D.N.Y. 1947), 79 F. Supp. 1013.

Precision Co. v. Automotive Co. (1945), 324 U.S. 806.

Patentee settled Patent Office interference wherein junior party filed false affidavit. District Court dismissed patent infringement action for unclean hands. Court of Appeals for Seventh Circuit reversed. Supreme Court reversed Court of Appeals and affirmed District Court.

Hazel-Atlas Co. v. Hartford Co. (1944), 322 U.S. 238.

Patentee filed article in Patent Office with spurious authorship to secure allowance of claims and relied upon article in Court of Appeals. Court of Appeals for Third Circuit denied relief from judgment and Supreme Court reversed.

Shawkee Mfg. Co. v. Hartford Co. (1944), 322 U.S. 271.

Patentee relied upon original *Hazel-Atlas* decision to secure favorable adjudication. Third Circuit Court of Appeals denied relief both on original appeal and on subsequent bill of review procedure. The Supreme Court reversed. In subsequent proceeding, damages were awarded to Glenshaw Glass Company, McKee Glass Company and Shawkee arising out of this decision. *Hartford-Empire Co. v. Shawkee Mfg. Co.* (3 Cir. 1947), 163 F. 2d 474.

II. Cases arising in the First Circuit which reached the Court of Appeals

Marks v. Polaroid Corporation (D. Mass. 1955), 129 F. Supp. 243.

A patent infringement action was defended in part upon the ground that the patentee made false representations to the Patent Office to obtain its patent. The Court found that the statement complained of was factually untrue but was not the result of a deliberate attempt to falsely represent the facts and that it did not deceive or mislead the examiner in his consideration of the patentability of the application pending before him. The defense was dismissed. This determination was affirmed on appeal in *Marks v. Polaroid Corporation* (1 Cir. 1956), 237 F. 2d 428. Certiorari was denied (1957), 352 U.S. 1005.

III. Cases arising in the First Circuit which did not reach the Court of Appeals

United States v. Standard Electric Time Company (D.Mass. 1957), 155 F. Supp. 949.

The government brought an action to cancel a patent on the ground of fraud insofar as the patentee did not disclose certain prior art known to him to the examiner. The action was dismissed on the ground that there was no evidence of fraud and there is no requirement that a solicitor for a patent must disclose all pertinent prior art to the examiner's attention and in part on the ground that the patentee in good faith could entertain the belief that the prior art was not pertinent.

IV. Cases arising in the Second Circuit which reached the Court of Appeals

Helene Curtis Industries v. Sales Affiliates (S.D. N.Y. 1954), 121 F.Supp. 490.

The alleged infringer asserted that the patentee concealed and suppressed the authorship and inconsistent results of certain tests which it submitted to the Patent Office and to the District Court, and contended that there was a deliberate distortion of test records, as well as a misrepresentation of the teachings of a prior art reference. The court could not say with any reasonable degree of certainty that there had been a deliberate misrepresentation and dismissed the unclean hands charge. The patent was, however, held invalid on straight patent grounds. The finding of invalidity was affirmed in *Helene Curtis Industries v. Sales Affiliates* (2 Cir. 1956), 233 F. 2d 148, without reference to the fraud charges. Certiorari

was denied (1956), 352 U.S. 879. Rehearing was denied (1956), 352 U.S. 945.

Dictograph Products Co. v. Sonotone Corp. (S.D. N.Y. 1951), 95 F.Supp. 126.

Plaintiff brought an action to annul and set aside orders and decrees in the Patent Office in interference proceedings and on an appeal to the Board of Appeals of the Patent Office and to the United States Court of Customs and Patent Appeals. Plaintiff charged that by conspiratorial action the defendant obtained a patent through a sinister fraud practiced on the Patent Office and the Court of Customs and Patent Appeals as well as on the plaintiff and its assignor. The court denied a motion for summary judgment stating that res judicata is no answer to the claim. This determination was subsequently overruled. Res judicata was held applicable in *Dictograph Products Company v. Sonotone Corporation* (2 Cir. 1956), 230 F. 2d 131. A petition for rehearing was denied in *Dictograph Products Co. v. Sonotone Corporation* (2 Cir. 1956), 231 F. 2d 867. A petition for writ of certiorari was dismissed per stipulation pursuant to Rule 60 (1956), 352 U.S. 883.

V. Cases arising in the Second Circuit which did not reach the Court of Appeals

I.C.E. Corporation v. Armco Steel Corp. (S.D.N.Y. 1961) 201 F.Supp. 411.

This was a declaratory judgment action in which the plaintiff alleged that the defendant obtained issuance of the patent upon fraudulent misrepresentations to the Patent Office. A motion to strike was granted on the ground

that charges of fraudulent misrepresentations used in connection with the issuance of a patent are not available as a basis for affirmative relief in private litigation regarding the validity of a patent.

VI. Cases arising in the Third Circuit which reached the Court of Appeals

Hardinge Company, Inc. v. Jones & Laughlin Steel Corp. (W.D.Penn. 1958), 164 F.Supp. 75.

A patent infringement claim was defended in part on the ground of unclean hands in that the applicant falsely represented to the examiner that a certain prior art German patent cited by the examiner was inoperative. The District Court denied a motion for summary judgment based on this ground and plaintiff subsequently caused the action to be dismissed with prejudice. The denial of attorneys' fees was held not to be an abuse of discretion in *Hardinge Company, Inc. v. Jones & Laughlin Steel Corp.* (3 Cir. 1960), 275 F. 2d 37. Certiorari was denied (1960), 363 U.S. 828.

Baldwin-Lima-Hamilton Corp. v. Tatnall Meas. Sys. Co. (E.D.Penn. 1958), 169 F.Supp. 1.

A patent infringement action was defended on the ground that the patentee knowingly made false statements to the Patent Office which induced it to grant the patent following the earlier rejection. The defense was stricken on the ground that the proof of the fraud did not meet proper evidentiary standards. The patent was, however, held unenforceable because patent misuse on other grounds in violation of the antitrust laws. This latter determination was affirmed in *Baldwin-Lima-Hamilton Corp.*

v. Tatnall Meas. Sys. Co. (3 Cir. 1959), 268 F. 2d 395. Certiorari was denied (1959), 361 U.S. 894.

Tipper Tie v. Hercules Fasteners (D.N.J. 1955), 130 F.Supp. 3.

The defense was made that the patentee failed to call certain prior art known to it to the attention of the Patent Office. The court held that this was not fraud but that the neglect rendered the presumption of validity weak, indeed. This was affirmed per curiam in *Tipper Tie v. Hercules Fasteners* (3 Cir. 1956), 232 F. 2d 635.

Etten v. Lovell Mfg. Co. (W.D.Penn. 1949), 83 F. Supp. 178.

Plaintiff lost an interference in the Patent Office and brought an action to authorize the issuance of the patent to him and for declaratory judgment for injunction and damages. The court found that the defendants fraudulently procured a patent when they knowingly and deliberately submitted and caused to be submitted to the Patent Office false and untrue evidence and affidavits while concealing and suppressing other pertinent evidence in the files of their attorneys. The court held that the prior interference proceedings were not res judicata but denied plaintiff's claim for damages on the ground of conspiracy. The judgment was vacated in *Etten v. Lovell Mfg. Co.* (3 Cir. 1950), 184 F. 2d 737, for a determination as to whether the plaintiff had a legal interest which entitled him to maintain the action. The Supreme Court denied certiorari (1951), 340 U.S. 931. On remand the plaintiff was held entitled to maintain the suit in *Etten v. Lovell Mfg. Co.* (W.D.Penn. 1954), 121 F.Supp. 291. This was affirmed in *Etten v. Lovell Manufacturing Com-*

pany (3 Cir. 1955), 225 F. 2d 844, both on res judicata and on the fraud facts and conclusions. Certiorari was denied (1956), 350 U.S. 966.

Pangborn Corporation v. American Foundry Equip. Co. (3 Cir. 1946), 159 F. 2d 88.

This was a case to enjoin prosecution of a patent interference proceedings, to require restoration of patent application to status of abandoned application and for treble damages under the antitrust laws. One of the parties contended that a patent applicant had filed a false affidavit to obtain the revival of an abandoned application. The Court held that it had no jurisdiction of the subject matter until after the patent issued by the patent office. Subsequent proceedings in *Pangborn Corporation v. American Foundry Equip. Co.* (3 Cir. 1948), 170 F. 2d 339, at page 342, disclose that the Commissioner of Patents did conclude that the revival had been procured by fraud on the Patent Office and it dissolved the interference in question.

VII. Cases arising in the Third Circuit which did not reach the Court of Appeals

Dimet Proprietary v. Industrial Metal Protectives (D.Dela. 1952), 109 F.Supp. 472.

Plaintiff brought an action for declaratory judgment as to invalidity of defendant's patent. Several paragraphs of the complaint which alleged fraud in the procurement of a patent were stricken on the ground that suit by the United States is the sole method whereby a patent can be cancelled or nullified for fraud.

United States v. Hartford-Empire Co. (D.Dela. 1947), 73 F.Supp. 979.

In this case the government brought an action to cancel several Hartford-Empire patents on the ground of fraud. The defendant raised the defense of res judicata by virtue of *Hartford-Empire Co. v. Coe* (D. of C. Cir. 1936), 87 F. 2d 741. The court accepted the allegations of fact in the complaint as true and struck the res judicata defense.

VIII. Cases arising in the Fourth Circuit which reached the Court of Appeals

Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp. (D.Md. 1963), 218 F. Supp. 1.

A patent infringement suit was defended in part on the ground that the applicant for the patent willfully concealed certain prior art from the examiner. The court found it unnecessary to characterize the conduct of the prosecution because it found the patent invalid and the conduct therefore harmless. The judgment was affirmed in *Technograph Printed Circuits, Ltd. v. Bendix Corporation* (4 Cir. 1964), 327 F. 2d 497.

United States Pipe and Foundry Co. v. Woodward Iron Co. (4 Cir. 1964), 327 F. 2d 242.

This was an action for patent infringement in which the defendant alleged fraud on the part of the patentee on the premise that a disclaimer agreement was filed in the Patent Office to conceal the true inventor of the invention. The District Court found no fraud in the transaction and the Court of Appeals affirmed.

Triumph Hosiery Mills, Inc. v. Alamance Industries, Inc. (M.D. N.C. 1961), 191 F.Supp. 652.

A declaratory judgment action against the patentee was supported in part by a charge that the patentee in obtaining the patent did not call the examiner's attention to a prior public use of the patented stocking. The court entered a decree that the patent in suit had been rendered invalid by reason of such concealment of the prior art. The fraud determination was reversed in *Triumph Hosiery Mills, Inc. v. Alamance Industries, Inc.* (4 Cir. 1962), 299 F. 2d 793 on the ground that there was not the required standard of a clear and definite showing of fraud. The entire patent, however, was held invalid for want of invention. Certiorari was denied (1962), 370 U.S. 924.

American Chain & Cable Co. v. Rochester Ropes (4 Cir. 1952), 199 F. 2d 325.

A patent infringement action was defended and a counterclaim for restitution was filed based on the charge that the owner of the patent did not come into the Patent Office with clean hands and was guilty of reprehensible conduct during the progress of the Briggs patent through the Patent Office. It was charged that the plaintiff secured the patent by making a settlement in an interference so that the facts with regard to the merits of the case were improperly suppressed and evidence of commercial success withheld the fact that license agreements contained price fixing provisions. The charge was dismissed by the District Court for insufficient evidence and this was sustained on appeal.

Orrison v. C. Hoffberger Co. (D.Md. 1951), 97 F. Supp. 689.

The applicant for a patent filed an affidavit as to commercial success to obtain his patent which contained a factual misstatement. It was found that the misstatement was the result of inadvertence and was not fraudulent. The patent was held invalid over the prior art. The judgment of invalidity was sustained in *Orrison v. C. Hoffberger Co.* (4 Cir. 1951), 190 F. 2d 787.

Mas v. Coca-Cola Co. (4 Cir. 1947), 163 F. 2d 505.

An action to have plaintiff adjudged entitled to a design patent on a beverage bottle was dismissed on the ground that plaintiff had not come into court with clean hands. Plaintiff's counsel admitted that copies of letters in the Patent Office files were not genuine.

IX. Cases arising in the Fourth Circuit which did not reach the Court of Appeals

Marshall v. Procter & Gamble Manufacturing Company (D.Md. 1962), 210 F.Supp. 619.

A patent infringement action was defended in part on the ground that the patentee falsely represented his examples to the Patent Office. The court did not grant relief on this ground but held that the false claims neutralized the statutory presumption of validity and held that patent invalid.

X. Cases arising in the Fifth Circuit which reached the Court of Appeals

Bros Incorporated v. W. E. Grace Manufacturing Company (5 Cir. 1963), 320 F. 2d 594.

In this patent infringement case, a motion for relief from a patent infringement judgment was made on the ground that the patentee himself had put the patented product in public use and on sale more than one year prior to filing the application. The trial court denied the relief but the Court of Appeals held relief appropriate. The court considered the question as to whether the prior denial of a motion under Rule 60(b) by the Court of Appeals for the Sixth Circuit was res judicata and held that it was not res judicata. On remand in *Bros Incorporated v. W. E. Grace Manufacturing Company* (N.D. Tex. 1964), 227 F.Supp. 759, the District Court vacated the earlier judgment of infringement and found that the maker's knowledge of the falsity of a material misrepresentation of fact is not a necessary element of fraud.

James B. Clow & Sons, Inc. v. United States Pipe & Foundry Co. (5 Cir. 1963), 313 F. 2d 46.

A patent infringement complaint was defended on the ground that the plaintiff procured the patent in suit by fraud made in connection with the settlement of an interference proceeding. The trial court found that the defense was not proved in *United States Pipe & Fdry. Co. v. James B. Clow & Sons, Inc.* (N.D. Ala. S.D. 1962), 205 F. Supp. 140. The Court of Appeals affirmed.

Edward Valves, Inc. v. Cameron Iron Works, Inc. (5 Cir. 1961), 286 F. 2d 933.

A patent infringement suit was defended on the ground that the patentee made misrepresentations to the Patent

Office to obtain the grant of the patent in suit. The claim was made that the patentee represented that he had constructed and successfully tested the valve disclosed in his application whereas the test valve was inherently incapable of successful operation as built. The defense was stricken because the statement was not essentially material to the issuance of the patent. An antitrust counterclaim was dismissed in *Cameron Iron Works, Inc. v. Edward Valves, Inc.* (S.D. Tex. 1959), 175 F.Supp. 423. Certiorari was denied (1961), 368 U.S. 833.

Seismograph Service Corporation v. Offshore Raydist (5 Cir. 1958), 263 F. 2d 5.

This was a patent infringement action which was dismissed because of the patentee's unclean hands in filing a patent application while negotiating with an inventor who was working in the same field and preparing the application to cover the developments of that inventor. The lower court decision is reported in 135 F.Supp. 342.

XI. Cases arising in the Fifth Circuit which did not reach the Court of Appeals

None found.

XII. Cases arising in the Sixth Circuit which reached the Court of Appeals

E. W. Bliss Company v. Cold Metal Process Company (N.D. Ohio E.D. 1959), 174 F.Supp. 99.

The defense was made that there was improper conduct in handling several patent applications in the Patent Office. One ground was held to lack merit and the other

ground was held binding on the basis of *United States v. Cold Metal Process Co.* (N.D. Ohio E.D. 1945), 62 F.Supp. 127, affirmed (6 Cir. 1947), 164 F. 2d 754. The case was affirmed without discussion of this point in *Cold Metal Process Company v. E. W. Bliss Company* (6 Cir. 1960), 285 F. 2d 231. Certiorari was denied (1961), 366 U.S. 911.

Aluminum Company of America v. Sperry Products, Inc. (6 Cir. 1960), 285 F. 2d 911.

The charge was made that the patentee made misrepresentations of fact to the Patent Office which induced the allowance of the patent. The trial court found that the estimates and representations were immaterial and overruled the defense in *Sperry Products, Inc. v. Aluminum Company of America* (N.D. Ohio E.D. 1959), 171 F.Supp. 901. This was affirmed on appeal.

Becton-Dickinson & Co. v. Robert P. Scherer Corp. (E.D. Mich. S.D. 1952), 106 F.Supp. 665.

In a declaratory judgment suit the plaintiff charged that the patentee committed a fraud on the Patent Office and on the plaintiff by representing that he was a sole inventor when the patented subject matter in truth involved either prior inventorship of third parties or co-inventorship with other third parties. The court dismissed the fraud charge for failure of proof. The Court of Appeals affirmed the findings that fraud in obtaining the patent was not proved. *Becton Dickinson & Co. v. R. P. Scherer Corp.* (6 Cir. 1954), 211 F. 2d 835.

Huszar v. Cincinnati Chemical Works (6 Cir. 1949), 172 F. 2d 6.

In this case the patentee swore that his invention had not been in public use and the evidence at the trial disclosed that the invention was not his sole creation and had been in public use. The District Court held that the patents were invalid on the public use and that they were further invalid because of fraud of the patentee in executing affidavits to the effect that the disclosed devices had not been in public use and because the alleged inventions were the joint and composite product of various persons so that the patentee was not their sole creator or originator. The Court of Appeals eliminated the finding of fraud because fraud must be proved by clear and convincing evidence and there must have been an intention to deceive.

United States v. Cold Metal Process Co. (N.D. Ohio E.D. 1945), 62 F.Supp. 127.

The government brought suit to cancel a patent in part because of alleged fraud. A charge that the same law firm handled two conflicting applications owned by different parties was held to be proper. A charge that a false affidavit was used to obtain allowance of the application was held to be not fraudulent on the ground that the representations were not unequivocal. The Court of Appeals affirmed the dismissal of complaint on the ground that neither fraud nor mutual mistake of fact existed in the procurement of the patent because the applicant believed statements of fact made in his affidavits made during patent prosecution were true and when considered in their entirety were true. *United States v. Cold Metal Process Co.* (6 Cir. 1947), 164 F. 2d 754. The Supreme Court denied certiorari (1948), 334 U.S. 811, as well as rehearing, 334 U.S. 835.

Mueller v. Campbell (S.D. Ohio, W.D. 1945), 59 F. Supp. 464.

The defendant in this case filed a false preliminary statement under oath in an interference between defendant and plaintiff so as to antedate the patented machine. The interference was not settled or compromised and the defendant defaulted. This was held to be not unclean hands with regard to the patent. The Court of Appeals affirmed the disposition of the fraud charges on the merits. *Campbell v. Mueller* (6 Cir. 1947), 159 F.2d 803.

General Metals Powder Co. v. S. K. Wellman Co. (N.D. Ohio, E.D. 1944), 57 F.Supp. 220.

In order to obtain patent, patentee filed affidavits in Patent Office which were proved to be inaccurate by subsequent experiments and evidence. The District Court held that the affidavits were not intentionally false and were not evidence of bad faith or fraudulent motive. Patent was held invalid on other grounds. The judgment was affirmed in *General Metals Powder Co. v. S. K. Wellman Co.* (6 Cir. 1946), 157 F. 2d 505 without discussion of the affidavit. Both certiorari and rehearing were denied in 329 U.S. 812, and 330 U.S. 854, respectively.

XIII. Cases arising in the Sixth Circuit which did not reach the Court of Appeals

Clinton Engines Corp. v. Briggs & Stratton Corp. (E.D. Mich. S.D. 1959), 175 F.Supp. 390.

Plaintiff brought an action for alleged violation of the antitrust laws charging that the defendant in a patent infringement action deliberately and fraudulently with-

held from the Patent Office his knowledge of prior art and previous public use of the invention. The District Court denied a motion for summary judgment based in part on the defense that the patentee had been exonerated of fraud in the earlier patent infringement trial.

Cutting Room Appliances Corp. v. Weatherbee Coats (N.D. Ohio E.D. 1950), 158 F.Supp. 231.

In this case the prevailing party asked for attorneys' fees on the ground that the plaintiff did not disclose to the patent office examiner certain prior art known to it. The court held that this fact in itself without further evidence is not sufficient proof of fraud in the prosecution of the patent to warrant attorneys' fees.

W. E. Plechaty Co. v. Heckett Engineering (N.D. Ohio E.D. 1956), 145 F.Supp. 805.

The court held that a patentee could not obtain equitable relief because of the inventor's failure to disclose a prior German patent in his affidavits filed in the Patent Office.

Foundry Equipment Company v. Carl-Mayer Corporation (N.D. Ohio E.D. 1955), 128 F.Supp. 640.

A patent infringement action was defended upon the ground that the patent was void because of certain misrepresentations made by the patentee to the Patent Office when he applied for his patent. It was admitted that the inconsistencies were not the result of any fraudulent intent on the part of the applicant for the patent. The defense was overruled but the patent was held invalid on straight patent grounds.

Clark v. Ace Rubber Products (N.D. Ohio, E.D. 1952), 108 F.Supp. 200.

A patent infringement action was defended on the ground that the patentee did not come into court with clean hands because an affidavit filed with the Patent Office was false. The court found that the affidavit was somewhat ambiguous and it may well be that the patentee considered his representation to have been a truthful statement. The unclean hands defense failed. The patent was held invalid on other grounds.

XIV. Cases arising in the Seventh Circuit which reached the Court of Appeals

Locklin v. Switzer Brothers, Inc. (7 Cir. 1964), 335 F. 2d 331.

In this case an adjudicated infringer by counterclaim in a patent infringement action and by complaint in an independent action sought relief under the antitrust laws alleging that the patentee obtained a patent by practicing fraud on the Patent Office and secured validity of the patent by practicing fraud on a federal district court and a federal court of appeals. The District Court and the Court of Appeals both held that prior motion proceedings to reopen a patent infringement judgment were res judicata. The Supreme Court denied certiorari on January 18, 1965 as No. 581.

Armour and Company v. Wilson & Co. (N.D. Ill. E.D. 1958), 168 F.Supp. 353.

A patent infringement action was defended in part on the ground that the patentee made a false and misleading statement to the Patent Office in filing a continuation in

part application. The District Court held that this invalidated the patent. It held the patent invalid on other grounds as well. The fraud defense was reversed in *Armour & Co. v. Wilson & Co.* (7 Cir. 1960), 274 F. 2d 143, on the ground that the charges were not established by the requisite degree of proof. The invalidity of the patent on other grounds was sustained.

The Diversey Corporation v. Charles Pfizer and Co. (7 Cir. 1958), 255 F. 2d 60.

This was a patent infringement action which was dismissed on the merits and also on the ground of unclean hands. The unclean hands consisted in the filing of a false affidavit relating to the need for taking certain depositions during pretrial discovery. Cross petitions for the writ of certiorari were dismissed under Rule 60 on October 29, 1958, in 358 U.S. 876.

Unilectric, Inc. v. Holwin Corporation (7 Cir. 1957), 243 F. 2d 393.

This was an action by a licensee of a patent against the licensor in which the licensee attacked the validity of the license on the ground that the patent was void ab initio and unenforceable by reason of fraud in the procurement of the patent. The offer of proof rejected by the trial court consisted of certain depositions alleged to show that the patentee and an officer of the company had knowledge of certain prior art which made failure to disclose them to the Patent Office amount to fraud. The District Court and the Court of Appeals both held the evidence insufficient to prove the charge. The decision below is reported in 143 F.Supp. 492. Certiorari was denied (1957) in 355 U.S. 830.

Hazeltine Research v. Avco Manufacturing Corp. (7 Cir. 1955), 227 F.2d 137.

The patent infringement action was defended on the ground that reissue application was tainted with fraud. The trial court found in fact that the record fails to establish that there was any fraud representation or misrepresentation or any material fact to the Patent Office or concealment of any material fact from the Patent Office in connection with the filing of a reissue application or its prosecution. *Hazeltine Research v. Avco Manufacturing Corp.* (N.D. Ill. E.D. 1954), 126 F.Supp. 595. This was affirmed on appeal. Certiorari was denied (1956), 350 U.S. 987.

XV. Cases arising in the Seventh Circuit which did not reach the Court of Appeals

Mallard v. Kitto (N.D. Ill. E.D. 1946), not officially reported, 69 USPQ 568.

The District Court held it to be unclean hands for an applicant for patent to have changed the dates on certain exhibits and to have falsely testified as to when words were placed upon another exhibit. No appeal was taken. On subsequent proceedings in the Patent Office, the entire patent application was stricken from the Patent Office files on the ground of fraud in *ex parte Mallard* (C.D. 1946), 71 USPQ 294.

W. F. & John Barnes Co. v. International Harvester Co. (N.D. Ill. E.D. 1943), 51 F.Supp. 254, 280.

Patentee filed false affidavit in patent office to secure allowance of application. Fraud and fraudulent intent de-

nied. In absence of full discussion of the question of an appropriate penalty, none was assessed. Patent held invalid on other grounds. No appeal taken.

XVI. Cases arising in the Eighth Circuit which reached the Court of Appeals

None found.

XVII. Cases arising in the Eighth Circuit which did not reach the Court of Appeals

None found.

XVIII. Cases arising in the Ninth Circuit which reached the Court of Appeals

Pursche v. Atlas Scraper and Engineering Co. (9 Cir. 1961), 300 F.2d 467.

This was a patent infringement action in which the infringer alleged that the patentee attempted to pirate another's invention and deliberately misrepresented himself to the officials of the Patent Office in order to gain the monopoly. The defense was overruled on the merits in the trial court and the Court of Appeals affirmed. Certiorari and rehearing were denied in 1962, 371 U.S. 911 and rehearing was denied in 1963, 371 U.S. 959.

Locklin v. Switzer Brothers, Inc. (9 Cir. 1961), 299 F.2d 160.

This was a patent infringement suit in which the adjudicated infringer brought a motion for a new trial based upon alleged proof of deception practiced by the patentee

and patent owner both on the Patent Office and on the District Court. The trial court denied the motion for a new trial and the Court of Appeals affirmed. Certiorari and rehearing were denied (1962) in 369 U.S. 861, 891.

XIX. Cases arising in the Ninth Circuit which did not reach the Court of Appeals

Martin v. Ford Alexander Corporation (S.D. Cal. 1958), 160 F.Supp. 670.

A patent infringement action was defended on the ground of fraud practiced on the Patent Office which consisted of the statement in some affidavits secured by counsel for the patentee to the effect that affiants knew of no apparatus seeking to achieve the same results. The evidence disclosed that the affidavits did not conform to the facts. There was no evidence that the affidavits had the effect of expediting the granting of the applications. The defense was stricken on the ground that scienter was lacking. The patents were held valid and infringed.

Wooldridge Mfg. Co. v. R. G. La Tourneau, Inc. (N.D. Cal. N.D., 1948), 79 F.Supp. 908.

This case was an action for declaratory relief and for violation of the antitrust laws alleging that the defendant obtained a reissue patent by fraud and as a part of a conspiracy to restrain trade. Defendant brought a motion to strike the fraud allegations and the antitrust cause of action. The court denied both motions.

XX. Cases arising in the Tenth Circuit which reached the Court of Appeals

Admiral Corporation v. Zenith Radio Corporation (10 Cir. 1961), 296 F.2d 708.

This was an action for infringement of patents in which the Court of Appeals affirmed their validity and infringement. The court denied an unclean hands defense based upon the contention that certain patents were unenforceable because the patent solicitors filed and prosecuted the applications without bringing to the attention of the Patent Office a certain prior art patent. The trial court found that the solicitors acted in good faith and were under no professional obligation or moral duty to call the specified patent to the attention of the Patent Office while the application was pending. This decision affirmed 190 F.Supp. 41.

XXI. Cases arising in the Tenth Circuit which did not reach the Court of Appeals

Dubuque Products, Inc. v. Lemco Corporation (D. Utah, 1963), 227 F.Supp. 108.

A patent infringement action was defended in part on the ground that the patentee was guilty of fraud in not advising the patent office of a patent and publication of which it had knowledge and of its own sales of a related product which occurred more than one year prior to the application date. The court held that there was no fraud because the differences between the devices of the prior art and those of the patent were such substantial nature that the plaintiff was not obliged to divulge them to the Patent Office. The patent was held valid and infringed.

Interstate Bakeries v. General Baking Co. (D. Kan. S.D. 1948), 84 F.Supp. 92.

In this case the patentee filed a false claim for inventorship and the court held that evidence of this false claim deprived the patent in suit of any presumption of validity.

XXII. Cases arising in the District of Columbia which reached the Court of Appeals

Haloro, Inc. v. Owens-Corning Fibreglas Corporation (D. of C. Cir. 1959), 266 F.2d 918.

This was a patent infringement action in which the trial court held that a patent obtained in earlier 4915 proceedings was unenforceable because the patent had been procured by fraud and inequitable conduct. The representations had to do with the commercial success of the invention. The Court of Appeals held that the evidence of fraud and inequitable conduct was not sufficient to meet the required standards and reversed the court below. After a trial on the remand the court below and the Court of Appeals both held the patent invalid for want of invention in *Haloro, Inc. v. Owens-Corning Fibreglas Corporation* (D. of C. Cir. 1961) 288 F.2d 148.

XXIII. Cases arising in the Court of Customs and Patent Appeals

Kruger v. Resnick (CCPA 1952), 197 F.2d 348.

In its brief on appeal in an interference proceeding, the losing party asserted that perjury existed below. The court held that the issue was not before the court because

not mentioned in the reasons for appeal and that the subject matter should be brought to the attention of appropriate officials.

Smith v. Hayward (CCPA, 1951), 193 F.2d 198.

The losing party in interference proceedings brought a bill in review alleging that the prevailing party perpetrated a fraud upon the court in earlier proceedings. The petition was denied in part for lack of diligence and in part because there was no merit whatever with respect to any fraud or misrepresentation on the part of the prevailing party, his witnesses, or his counsel in the involved litigation.

Josserand v. Taylor (CCPA, 1946), 159 F.2d 249.

A petition to reopen interference proceedings was brought on the ground that perjured testimony concerning a prior public use and reduction to practice was used by the prevailing party in the original interference. The Court found that the allegations showed intrinsic fraud and denied the petition to reopen. Subsequently, the Commissioner of Patents entered an order that a prima facie case of fraud had been established and ordered the applications stricken from the file subject to an order to show cause. This issue became moot upon a determination that the application was invalid because of public use as appears from *application of Josserand* (CCPA, 1951), 188 F.2d 486. The determination on the fraud issues was subsequently held to be res judicata in *Taylor v. Marzall* (C. A. D. C. 1952), 196 F.2d 592.